

## **REMARKS/ARGUMENTS**

### **The Status of the Claims.**

Claims 1-39 are pending with entry of this amendment, claim 36 being cancelled and claims 37-39 being added herein. Claims 6 and 24-29 have been withdrawn from further consideration by the Examiner. Applicants respectfully request that these dependent claims be reconsidered should claim 1 be found allowable.

Claims 14 and 18 are amended herein. These amendments introduce no new matter and support is replete throughout the specification. These amendments are made without prejudice and are not to be construed as abandonment of the previously claimed subject matter or agreement with any objection or rejection of record. With respect to amended claim 14 and new claims 37-39, support for the compositions can be found in the specification at, for example, page 16, lines 3-5. With respect to claim 18, support for the cell lines relevant to a particular disease area of interest can be found in the specification at, for example, page 8, lines 8-10, and page 10 line 30 through page 11, line 3.

Applicant submits that no new matter has been added to the application by way of the above Amendment. Accordingly, entry of the Amendment is respectfully requested.

### **The Election/Restriction Requirement.**

Pursuant to a restriction requirement made final, Applicant cancels claim 36 with entry of this amendment. Please note, however, that Applicant reserves the right to file subsequent applications claiming the canceled subject matter and the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

### **The Information Disclosure Statement.**

Applicant notes with appreciation the Examiner's thorough consideration of the references cited in the Information Disclosure Statement (Form 1449) submitted on April 18, 2002 and August 19, 2002.

### **35 U.S.C. §112, Second Paragraph.**

Claims 14, 16, and 18-19 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant traverses the rejections as follows.

Claim 14 was rejected for use of the term "analogs." While Applicant believes that one of skill in the art would know (or could readily ascertain) what modifications are encompassed by this term, in the interest of furthering prosecution, Applicant has amended claim 14 and added new claims 37-39 to recite specific classes of compounds. Applicant respectfully requests that the rejection be withdrawn in light of the amended claim.

Claim 16 was rejected for the use of the term "target specific" with respect to the cell lines employed in the methods of the subject invention. Applicant notes that the term is amply defined in PCT publication WO 01/71023 (PCT/US01/08670), which was incorporated by reference into the specification (see page 5, lines 29-31; page 15, lines 15-16; and page 35, line 29 through page 36, line 15). Per *In Re Howarth*, 654 F.2d 103, 210 USPQ 689,692 (CCPA 1981), the disclosure of a patent application may be supplemented by reference to any disclosure which is available to the public. Applicant respectfully submits that the phrase "target specific" is adequately defined in the incorporated reference, and respectfully requests that the rejection be withdrawn.

Claims 18 and 19 were rejected for the use of the term "optimized" with respect to the cell lines employed in the methods of the subject invention. While Applicant believes that one of skill in the art would know what is encompassed by a cell line that has been "optimized" for use, in the interest of furthering prosecution, Applicant has amended claim 18 to further clarify the claimed invention. Applicant respectfully requests that the rejection be withdrawn in light of the amended claim.

### **35 U.S.C. §103(a).**

Claims 1-4, 7-21, 26 and 33-35 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Vande Woude et al (USPN 5,645,988). Applicant traverses.

Three requirements must be met for a *prima facie* case of obviousness. First, the prior art reference must teach all of the limitations of the claims. M.P.E.P. § 2143.03. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. M.P.E.P. § 2143.01. Third, a reasonable expectation of success is required. M.P.E.P. § 2143.02. The teaching or suggestion to combine and the expectation of success must be both found in the prior art and not based on Applicant's disclosure. M.P.E.P. §2143.

Claim 1 is drawn to methods of identifying a new composition with a desired activity> The methods include the steps of a) providing a first set of compositions, wherein at least one member of the first set of compositions comprises at least a first demonstrated activity and a second desired activity; b) determining a genetic response profile for each member composition of the

first set of compositions using a plurality of cell lines; c) comparing the one or more responses from the genetic response profile to the first demonstrated activity and second desired activity of each member composition, thereby identifying a pattern of responses correlating to a decrease in the first demonstrated activity and an increase in the second desired activity; and d) screening a second set of compositions for the pattern of responses, thereby identifying a new composition with the desired activity. In this manner, one or more compounds having the second desired activity can be identified using information related to the demonstrated first activity (see, for example, page 6, lines 23-31 of the specification).

As noted above, a *prima facie* case of obviousness requires that the cited art, taken with the general knowledge in the field, must provide all of the elements of the claimed invention. Vande Woude is alleged to teach a method of identifying a drug having a desired activity by contacting cancer cell lines with sets of compositions. However, the cited art does not provide all of the elements of the claimed invention. For example, Vande Woude does not teach or disclose comparing the one or more responses from the genetic response profile to both the first demonstrated activity and second desired activity of each member composition. Nor does Vande Woude teach or disclose identifying a pattern of responses correlating to a decrease in the first demonstrated activity and an increase in the second desired activity. Rather, he determines whether there is a correlation between the effect of the drug (e.g., the first known activity) and the presence or absence of a selected DNA sequence, without consideration of any second, desired activity or the relative activity levels (column 5, lines 33-50). Since the cited art does not teach all of the limitations of the claimed invention, the first criteria for a *prima facie* case of obviousness has not been met. Applicant respectfully requests that the rejection be withdrawn.

### CONCLUSION

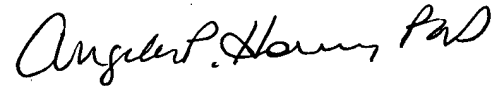
In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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Amdt. Dated June 29, 2004  
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If the claims are deemed not to be in condition for allowance after consideration of this Response, **a telephone interview with the Examiner is hereby requested.** Please telephone the undersigned at (510) 337-7871 to schedule an interview.

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Respectfully submitted,



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Attachments:

- 1) A petition to extend the period of response for **2** months;
- 2) A transmittal sheet;
- 3) A fee transmittal sheet; and
- 4) A receipt indication postcard.

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